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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/518,060 | 03/02/2000 | Andrew Scott Field | KDO.188020-1 | 5292 |

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| EXAMINER |
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POND, ROBERT M

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/518,060

Applicant(s)

FIELD ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant amended Claim 2. All pending claims (2, 3, and 5-11) were examined in this final Office Action necessitated by amendment.

Response to Arguments

Rejection under 35 USC 103(a)

Applicant's arguments, see Remarks, filed 13 July 2004, with respect to the rejection(s) of claim(s) 2, 3, and 5-11 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Greulich necessitated by amendment to independent Claim 2.

The Applicant amended Claim 2 and based arguments on the amended claim. The Applicant argues the prior art does not teach or suggest a pricing engine as amended, and that the prior art does not teach or suggest the pricing engine automatically and substantially instantaneously calculated a new price quote each time the customer selects or enters data for one or more new configuration options at the customer before forwarding to the processing computer at a printing service provider. As disclosed below, Greulich teaches a pricing system, automatic price updating to the customer before forwarding the final customer order to a production service provider.

Rejection under 35 USC 101

The Applicant amended Claim 2 to overcome the previous rejection under 35 USC 103(a) and in doing so, overcomes rejection under 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 2, 3, and 5-11 are rejected under 35 USC 102(b) as being anticipated by Greulich (patent number 5,241,464 hereinafter referred to as “Greulich”).**

Greulich teaches all the limitations of Claims 2, 3, and 5-11. For example, Greulich discloses the creation and ordering of custom business forms on a customer computer and transmitting ordering parameters, design, and verbiage electronically to an order-receiving computer for the printing of business forms. Greulich discloses automatic price calculation at the customer's computer based on inputting ordering information (see at least abstract; Fig. 1 (15, 17, 18, 12, 27); Fig. 4 (40); col. 1, line 53 through col. 2, line 11). Greulich further discloses:

- **Providing a customer a pricing engine; displaying automatically the price quote at the customer:** pricing includes one or more printing configuration

options selected by the customer; displaying on the customer computer (see at least Fig. 4 (46, 41); col. 6, lines 37-66); pricing system (see at least Fig. 8 (58); col. 8, lines 32-34).

- Graphical images: graphical representations; customer logo (see at least col. 5, line 21-28).
- Color: (see at least Fig. 4 (INK); col. 3, line 19; col.6, line 54).
- Payment: paying by credit card, cash on delivery, or account (see at least col. 9, lines 35-51).
- Proofing: proofing before final production (see at least Fig. 1 (22); Fig. 10b (22, 76); col. 10, line 5); displays printed page layout graphically to customer electronically prior to customer finalizing order (please note examiner's interpretation: customer proofing the order) (see at least Fig. 9ab (W)).
- Automatically calculating a price quote based on the one or more printing configurations options selected by the customer: pricing engine automatically and substantially instantaneously calculated a new price quote (see at least Fig. 8 (58); Fig. 9b (64); col. 5, lines 45-49; col. 8, lines 32-67).
 - each time the customer selects or enters data for one or more new configuration options at the customer: (see at least Fig. 9b (64); Fig. 9c (Update Pricing); Fig. 9e (Update Pricing); col. 8, line 63 through col. 9, line 63).

- before forwarding to the processing computer at a printing service provider: customer receives pricing updates to finalize the order before printing service provider (e.g. separate production site) receives the order (see at least Fig. 1 (27, 28); Fig. 9ad; Fig. 10b (27, 28); Fig. 11 (27, 28); col. 6, lines 6-11; col. 9, lines 52 through col. 10, line 60).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,134,568 (Tonkin) 17 October 2000; teaches previewing an assembled document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone

number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over the printed name and date.

Robert M. Pond
Patent Examiner
October 12, 2004